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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/049,504      | 06/18/2002  | Subramaniam Ananthan | 21381/0053US        | 7626             |

7590 12/08/2004  
Burton A Amernick  
Connolly Bove Lodge & Hutz  
PO Box 19088  
Washington, DC 20036-0088

EXAMINER

MORRIS, PATRICIA L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,504

Applicant(s)

ANANTHAN, SUBRAMANIAM

Examiner

Patricia L. Morris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1 and 7-11 are under consideration in this application.

Claims 2-6 and 12-16 remain held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

#### ***Election/Restriction***

The restriction requirement is deemed sound and proper and is hereby made FINAL.

Again, this application has been examined with regard to the elected compounds of formula (II) as set forth in claim 1, exclusively. It is suggested that the nonelected compounds be deleted.

#### ***Claim Rejections - 35 USC §103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dondio et al. for the reasons set forth in the previous Office action.

Again, Dondio et al. generically embrace the instant compounds. Note, for example, compounds set forth in Scheme 6 wherein R<sub>3</sub> is hydroxy, R<sub>1</sub> is cyclopropylmethyl, R<sub>4</sub> and R<sub>5</sub> together form an oxy group, R<sub>2</sub> is hydroxy, R<sub>5</sub> is hydrogen, R<sub>7</sub> and R<sub>6</sub> are phenyl, hydrogen, hydroxy, alkyl, etc.

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Applicants appear to argue that one having ordinary skill in the art would not have been motivated to produce the compounds encompassed by the claims. The motivation is not abstract but is always related to the properties or uses that one having ordinary skill in the art would have expected the resulting compound to exhibit. In situations involving chemical compounds bearing a close structural similarity, the requisite motivation stems from the expectation that compounds exhibiting closely similar structures will exhibit similar properties. In the situation here, one would not have to modify the disclosure of Dondio et al., but merely employ compounds that are generically embraced by the disclosed formula of Dondio et al. As previously discussed, the requisite motivation for producing the claimed compounds stems from the fact that they are generically disclosed. Therefore, one having ordinary skill in the art would have found it *prima facie* obvious to select any on the compounds embraced by the generic formula, including those of the claims.

Further, applicants appear to base their arguments on patentability of the **nonelected compounds of formula (I), i.e., pyrrolomorphinans**.

The close structural analogy to the prior art provides the motivation to make and use the instant compounds as pharmacological agents; *In re Wood*, 199 USPQ 137; *In re Payne*, 203 USPQ 245 (both CCPA).

Applicants do not point to any objective evidence which demonstrates that the claimed compounds as a class exhibit any properties which are actually different from the closest prior compounds embraced by Muller et al. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977); *In re Hoch*, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970). Applicants have failed to present any objective evidence comparing the claimed compounds *vis-à-vis* the prior art compounds.

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***Conclusion***

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

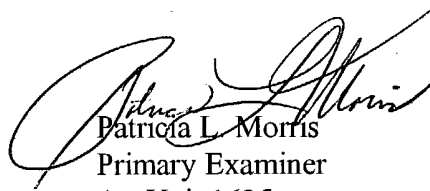
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Morris  
Primary Examiner  
Art Unit 1625

plm  
December 6, 2004